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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,429	12/27/2001	Aiko Okajima	016907-1353	1561
7590 10/19/2005 FOLEY AND LARDNER 3000 K Street NW Washington, DC 20007			EXAMINER PARK, CHAN S	
			ART UNIT 2622	PAPER NUMBER

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/026,429

Applicant(s)

OKAJIMA, AIKO

Examiner

CHAN S. PARK

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/27/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 1 is objected to because of the following informalities:
Line 10, "special printing" should be -- the special printing --;
2. With respect to claims 2, 5, 6, 7 and 11, arguments analogous to those presented for claim 1, are applicable.
Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 6-8, 11 and 12 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Ban U.S. Patent No. 6,332,170.

3. With respect to claim 1, Ban discloses a printer (network printer in fig. 1) comprising:
a receiving section (NIC 16 in fig. 2) which receives printing jobs;
a storage section which stores the received printing jobs (col. 3, lines 39-40);

a printing section which executes the printing jobs extracted from the storage section (fig. 4);

a determining section which determines whether the printing jobs received by the receiving section include special printing (fig. 4 & col. 2, lines 26-27);

a display section which displays a list of the printing jobs that are determined as including the special printing by the determining section (fig. 4 & col. 2, lines 26-27);

an input section which accepts a printing job selected by a user from the displayed list (fig. 4); and

a control section which extracts from the storage section the printing job selected by the user, and causes the printing section to execute it (col. 4, lines 19-38).

4. With respect to claim 2, Ban discloses the printer according to claim 1, wherein the control section extracts a printing job that does not include the special printing from the storage section and causes the printing section to execute it (col. 5, lines 11-25).

5. With respect to claim 3, Ban discloses the printer according to claim 1, wherein the special printing is printing on a special paper sheet other than a normal paper sheet (col. 2, lines 26-27).

6. With respect to claim 6, Ban discloses a print system comprising:

at least one terminal (computer) which receives data input for printing and sends a printing job for executing the printing based on the input data (fig. 1); and

a printer (network printer 1) which networked to the terminal and executes the printing job sent from the terminal to print data (fig. 1),

said printer comprising:

a receiving section which receives printing jobs send from the terminal (NIC 16 in fig. 2);

a storage section which stores the received printing jobs (col. 3, lines 39-40);

a printing section which executes the printing jobs extracted from the storage section (col. 3, lines 35-43);

a determining section which determines whether the printing jobs received by the receiving section include the special printing (fig. 6 & col. 2, lines 23-34);

a display section which displays a list of the printing jobs that are determined as including special printing by the determining section (col. 2, lines 26-27);

an input section which accepts a printing job selected by a user from the displayed list (fig. 4); and

a control section which extracts from the storage section the printing job selected by the user, and causes the printing section to execute it (col. 4, lines 21-38).

7. With respect to claim 7, Ban discloses the print system according to claim 6, wherein the control section extracts a printing job that does not include special printing from the storage section and causes the printing section to execute it (col. 5, lines 13-25).

8. With respect to claim 8, Ban discloses the print system according to claim 6, wherein the special printing is printing on a special paper sheet other than a normal paper sheet (col. 2, lines 26-27).

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9. With respect to claim 11, Ban teaches a printing method comprising:
- receiving printing jobs (NIC 16 in fig. 2);
 - determining whether the received printing jobs include special printing (fig. 3);
 - executing the printing jobs that are determined as not including special printing (col. 5, lines 13-25);
 - displaying a list of the printing jobs that are determined as including the special printing without executing them (fig. 4 & col. 4, lines 19-38);
 - accepting a printing job selected by a user from the displayed list (fig. 4); and
 - executing the printing job selected by the user (col. 4, lines 19-38).
10. With respect to claim 12, Ban teaches a printing method according to claim 11, wherein the special printing is printing on a special paper sheet other than a normal paper sheet (col. 2, lines 26-27).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ban as applied to claim 3 above, and further in view of Eisenberg et al. U.S. Patent No. 6,452,694 (hereinafter Eisenberg).

11. With respect to claim 4, Ban discloses the printer according to claim 3 but it does not disclose expressly that the special printing is printing on a special paper sheet is a tab paper sheet.

Eisenberg, the same field of endeavor of the special paper printer, discloses a printer for performing a special printing on a special paper sheet, wherein the special paper sheet is a tab paper (Abstract).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the tab paper printing system of Eisenberg into the printer of Ban.

The suggestion/motivation for doing so would have been to correctly print text and/or graphic objects in the tab area of the tab sheet.

Therefore, it would have been obvious to combine Ban with Eisenberg to obtain the invention as specified in claim 4.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ban as applied to claim 3 above, and further in view of Osari et al. U.S. Patent No. 6,169,863 (hereinafter Osari).

12. With respect to claim 5, Ban discloses the printer according to claim 3, further comprising:

a paper feed section which feeds a special paper sheet to the printing section (col. 3, line 31); and

a sensor which senses absence of a special paper sheet in the paper feed section (col. 3, lines 32-34),

wherein when a printing job including the special printing is selected by the user through the input section (col. 4, lines 6-38).

Ban, however, does not disclose expressly that the control section causes the display section to display absence of the special paper sheet, on condition that the sensor senses absence of the special paper sheet in the paper feed section.

Osari, the same field of endeavor of the manual feed-in printing system, discloses

a paper feed section which feeds a special paper sheet to the printing section (fig. 7A); and

a sensor which senses absence of a special paper sheet in the paper feed section (col. 8, lines 1-12),

a control section causes the display section to display absence of the special paper sheet, on condition that the sensor senses absence of the special paper sheet in the paper feed section (col. 8, lines 10-12).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the display of 'no sheet on the manual feed tray' into the printer of Ban.

The suggestion/motivation for doing so would have been to inform the user that there is no sheet present in the feed tray.

Therefore, it would have been obvious to combine Ban with Osari to obtain the invention as specified in claim 5.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ban as applied to claim 8 above, and further in view of Eisenberg.

13. With respect to claim 9, arguments analogous to those presented for claim 4, are applicable.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ban as applied to claim 8 above, and further in view of Osari.

14. With respect to claim 10, arguments analogous to those presented for claim 5, are applicable.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ban as applied to claim 12 above, and further in view of Eisenberg.

15. With respect to claim 13, arguments analogous to those presented for claim 4, are applicable.

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Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csp
September 9, 2005

Chan S. Park
Examiner
Art Unit 2622



EDWARD COLES

SUPERVISORY PATENT EXAMINER
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